



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,864	01/20/2004	Richard Paul White	010-CON1	3151
36215	7590	06/30/2008		
HAW-MINN LU				
10733 CALSTON WAY				
SAN DIEGO, CA 92126				
EXAMINER				
KANG, PAUL H				
ART UNIT		PAPER NUMBER		
2144				
MAIL DATE		DELIVERY MODE		
06/30/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/761,864

Applicant(s)

WHITE ET AL.

Examiner

Paul H. Kang

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-15 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 20 January 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-850)
Paper No(s)/Mail Date See Continuation Sheet
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

Continuation of Attachment(s) 3. Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :3/28/06;12/23/07;1/11/08;4/14/08.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. **10/761,883**, claims 1-15 of copending Application No. **10/761,894**, and claims 1-24 of copending Application No. **10/972,765**. Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the instant claims are the same as the context of the conflicting claims. The instant application and the copending applications all claim a system for rejecting or diverting spam messages by determining whether the message contains spam messages and rejecting or terminating the connection of the transfer session.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1-13 recites the limitation "unsolicited message blocking" in line 1 of claims 2-

15. There is insufficient antecedent basis for this limitation in the claim.

6. Claims 1-13 recites, as exemplary in lines 17-18 of claim 1 which recites "whereby MTA_1 controls the interaction between MTA_0 and MTA_1 before a RCPT command from MTA_0 is received." This claim clause is vague and/or ambiguous, in that it raises uncertainty as to whether it is the MTA_1 or the unsolicited message rejecting communications processor which receives the RCPT command. Further, the claimed limitation (c), raises uncertainties as to whether the rejected connection with MTA_0 recited in the whereby clause discussed above is with the intercepting means or with MTA_1 and whether the rejection is before the data portion of the unsolicited message is transmitted if the unsolicited rejecting communications processor is monitoring the communications between MTA_0 and MTA_1 as indicated in limitation (a) of

the claim. For the purposes of further examination, the examiner will interpret that the unsolicited message rejecting communications processor is the one that receives the RCPT command, and the connection with MTA_0 is with the unsolicited message rejecting communications processor and the rejected connection with MTA_0 is with the intercepting means. In further, the rejection with MTA_0 is before the data portion of the unsolicited message is transmitted to MTA_1.

7. Claim 10 is rejected because of the inconsistent use of terms and/or lack of antecedent basis. In this case, claimed term makes reference to "the real domain DD_1" on the third line of the claim, however on claim 1 from which claim 11 depends on, instead recites, "actual domain of DD_0", as such it lack antecedent basis. The disclosure as filed does not seem to provide clear support for this value in the specification. For the purposes of examination the claimed term "real domain DD_1" will be interpreted as the "actual domain of DD_0". Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-7, 10-11 and 14 are rejected under 35 U.S.C. 102(c) as being anticipated by Donaldson, US Pat. No. 7,249,175.

10. As to claim 1, Donaldson teaches an unsolicited message rejecting communications processor connected to message transfer agents MTA_0 with an Internet address of IP_0, from-address A_0, declared domain of D0, and actual domain of DD_0, and MTA_1 with an Internet address of IP_1 and to-address A_1 comprising:

a) monitoring means for monitoring the communications between MTA_0 and MTA_1 (col. 8, lines 25-36);

b) determining means for intercepting a RCPT replay from MTA_0, substituting diversion address A'_1 for to-address A_1 in RCPT reply and sending modified RCPT reply to MTA_1 if the message is determined to be unsolicited and if to-address is in the save_spam database (col. 40, lines 29-45; see also Figs. 13, 26 and 27; col. 15, lines 50-65; col. 3, line 57 - col. 4, line 2);

whereby MTA_1 controls the interaction between MTA_0 and MTA_1 before a RCPT command from MTA_0 is received and whereby the connection with MTA_0 is rejected before the data portion of the unsolicited message is transmitted (col. 40, lines 21-39, col. 3, lines 51-60 and col. 19, lines 23-26).

11. As to claim 2, Donaldson teaches the unsolicited message rejecting communications processor further includes a allow_address database and wherein the determining means

determines if a message is not unsolicited by checking if the IP_0 is in the allow_address database (col. 11, line 58 -col. 12, line 10).

12. As to claim 3, Donaldson teaches the unsolicited message rejecting communications processor further includes a prevent_address database and wherein the determining means determines if a message is unsolicited by checking if IP_0 is in the prevent_address database (col. 11, line 58 -col. 12, line 10).

13. As to claim 4, Donaldson teaches the unsolicited message rejecting communications processor further includes access to a open relay database and wherein the determining means determines if a message is unsolicited by checking if IP_0 is in the open relay database (col. 11, line 58 -col. 12, line 10).

14. As to claim 5, Donaldson teaches the unsolicited message rejecting communications processor further includes access to a DNS (domain name server) database and wherein the determining means determines if a message is unsolicited by checking if IP_0 has a domain name entry DD_0 in the DNS database (col. 11, line 58 -col. 12, line 10).

15. As to claim 6, Donaldson teaches the unsolicited message rejecting communications processor further includes a bad_from database and wherein the determining means determines if a message is unsolicited by checking if the from-address A_0 is in the bad_from database (col. 11, line 58 -col. 12, line 10 and col. 43, lines 7-39).

16. As to claim 7, Donaldson teaches the unsolicited message rejecting communications processor further includes a suspect_domain database and wherein the determining means determines if a message is unsolicited by checking if the actual domain DD_0 matches the domain of from-address A 0 and the domain of from-address A 0 is in the suspect_domain database (col. 11, line 58 -col. 12, line 10 and col. 21, lines 52-67).

17. As to claim 10, Donaldson teaches the unsolicited message rejecting communications processor wherein the determining means determines if a message is unsolicited by checking if the declared domain D 0 of MTA 0 does not match the actual domain of DD_0 and the declared domain D_0 is in the suspect_domain database (col. 11, line 58 -col. 12, line 10 and col. 21, lines 52-67).

18. As to claim 11, Donaldson teaches the unsolicited message rejecting communications processor further includes a no_filter database and wherein the determining means determines if the message is to be blocked by checking if to-address A_1 is in the no-filter database (col. 11, line 58 -col. 12, line 10).

19. As to claim 14, Donaldson teaches a method for a receiving networked computer system with an Internet connection, a .mail transport agent MTA_1, an Internet address IP_1, to-address A_1, a diversion address A' _1, a save_spam database (col. 13, lines 26-49; col. 40, lines 29-45; see also Figs. 13, 26 and 27; col. 15, lines 50-65), and an operating system capable of executing

the method to divert unsolicited messages from a transmitting networked computer system with an Internet connection and a message transfer agent MTA_0 (col. 11, lines 13-33), an Internet address IP_0, from-address A_0, declared domain D_0, and actual domain DD_0 (See col. 18, lines 5-7, col. 15, lines 62-64, col. 20, lines 4-5 and col. 3, lines 5-6) comprising the steps of:

a) waiting for a new SMTP connection request (col. 15, lines 21-31); b) relaying and monitoring the replies from MTA_0 to MTA_1 (col. 8, lines 25-28); c) relaying replies from MTA_1 to MTA_0 (col. 34, lines 3-5); d) intercepting the RCPT reply from MTA_0 to MTA_1 (col. 34, lines 3-5); e) determining if the message is unsolicited by analyzing the monitored replies (col. 15, lines 50-65); f) releasing the intercepted RCPT reply if the message is determined not to be unsolicited (col. 40, lines 29-34 and col. 20, lines 6-23 and col. 44, lines 3-16); and g) substituting diversion address A'1_1 for to-address A_1 in the RCPT reply and sending the modified replay to MTA_1 if the message is determined to be unsolicited and if recipient address A_1 is in the save_spam database (col. 40, lines 29-45; see also Figs. 13, 26 and 27; col. 15, lines 50-65; col. 3, line 57 - col. 4, line 2);

whereby MTA_1 controls the interaction between MTA_0 and MTA_1 until a \r\n end-of-message indicator reply is received from MTA_0 (col. 40, lines 29-34 and col. 20, lines 6-23 and col. 44, lines 3-16).

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donaldson in view of Levosky, in view of Wilson, US Pat. App. Pub. No. 2004/0015554.
22. As to claim 8, Donaldson teaches the invention substantially as claimed. However, Donaldson does not explicitly teach the unsolicited message rejecting communications processor wherein the determining means determines if a message is unsolicited by checking if the from-address A_0 matches the to-address (A_1). In the same field of endeavor, Wilson teaches the unsolicited message rejecting communications processor wherein the determining means determines if a message is unsolicited by checking if the from-address A_0 matches the to-address (A_1) (Wilson, paragraph 0084). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the known technique of matching from address to the to address to determine junk mail as taught by Wilson into the known unsolicited mail rejecting system of Donaldson for the predictable result of providing alternative methods of detecting junk mail.
23. As to claim 9, Donaldson teaches the unsolicited message rejecting communications processor wherein the determining means determines if a message is unsolicited by checking if the declared domain D_0 of MTA_0 is the same as the domain D_1 of MTA_1 (Wilson, paragraph 0084).

24. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donaldson in view of Levosky, US Pat. App. Pub. No. US 2002/0087641.

25. As to claim 12, Donaldson teaches the invention substantially as claimed. However, Donaldson does not explicitly teach the unsolicited message rejecting communications processor further includes a rejected_connection database which logs the time, from-address A_0, to address A_1, and the reason for the rejection if a message is rejected if the message is determined to be unsolicited. In the same field of endeavor, Levosky teaches the unsolicited message rejecting communications processor further includes a rejected_connection database which logs the time, from-address A_0, to address A_1, and the reason for the rejection if a message is rejected if the message is determined to be unsolicited (Levosky, paragraphs 0017 and 0063). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the known technique of using logs as taught by Levosky into the known system of Donaldson for the predictable result of enabling the storage of a record of past transactions.

26. As to claim 13, Donaldson-Levosky teaches the unsolicited message rejecting communications processor further includes a allowed_connection database which logs the time and to-address A_1 if the message is determine not to be unsolicited) Donaldson, col. 13, lines 26-29, col. 21, lines 14-17; Levosky, paragraphs 001- and 0063)

Conclusion

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H. Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul H Kang/
Primary Examiner
Art Unit 2144